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09/991,737	11/26/2001	Keiju Kishigami	1163-0369P	5555

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EXAMINER

GODDARD, BRIAN D

ART UNIT PAPER NUMBER

2161

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/991,737	KISHIGAMI, KEIJU	
	Examiner	Art Unit	
	Brian Goddard	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 8-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 8-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the Amendment filed 10 January 2006.
2. Claims 1, 2, 4-6 and 8-13 are pending in this application. Claims 1, 8, 12 and 13 are independent claims. In the Amendment filed 10 January 2006, claims 1, 4, 8 and 13 were amended. This action is made Final.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 2, 4-6 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,552,989 to Bertrand in view of U.S. Patent No. 5,325,482 to Bormans, and further in view of U.S. Patent No. 5,519,609 to Kuchenrither et al.

Claim 1:

Regarding Claim 1, Bertrand '989 teaches a navigation device for displaying dated map data (Bertrand '989: col. 1, Ins. 38-44) comprising:

- map storing means for storing the map data (Bertrand '989: col. 4, Ins. 39-40);
- specifying means of the map data to be displayed (Bertrand '989: col. 1, Ins. 44-47);

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- first display editing means for reading the map data as specified from said map storing means, and editing the map data to be displayed (Bertrand '989: col. 1, Ins. 44-47);
- displaying means for displaying the edited map data of the specific year as well as different map data (Bertrand '989: col. 1, Ins. 44-45);

However, Bertrand '989 does not explicitly disclose:

- storing data for a plurality of years;
- that the specifying means provides for specifying a specific year;
- that the displayed edited map data is of a different year;
- that the different edited map data is edited map data of a different year;

Nor does Bertrand '989 explicitly disclose:

- second display editing means for reading map data of a different year from said map storing means, and editing the map data to be displayed;
- wherein the edited map data from the specific year and the edited map data from the different year are superposed on the said displaying means; and
- wherein the map data includes at least one emphasized data item specified by said specifying means, and the displaying means displays both emphasized data items and normal data items.

Bormans teaches a means to create overlays over cartographic data.

Specifically, Bormans teaches:

- second display editing means for reading different map data (new map data in a first memory part) than that specified from said map storing means (old map

data in a second memory part), and editing the map data to be displayed (Bormans: See Abstract & col. 2, Ins. 4-39);

- wherein the edited map data from the specific year and the edited map data from the different year are superposed on said displaying means at the same time (Bormans: See display means 5, Abstract & col. 2, Ins. 4-39); and
- wherein the map data includes at least one emphasized data item (e.g. reference points for mains networks, highlighted in different color(s)) specified by said specifying means from a specific time period, and the displaying means displays both emphasized data items and normal data items from the different time period (Bormans: See display means 5, Abstract & col. 2, Ins. 4-39).

However, Bormans does not explicitly disclose:

- storing data for a plurality of years;
- that the specifying means provides for specifying a specific year;
- that the displayed edited map data is of a different year;
- that the different edited map data is edited map data of a different year;

Kuchenrither discloses a mapping overlay system similar to those of Bertrand and Bormans. Specifically, Kuchenrither discloses:

- storing data for a plurality of years (Kuchenrither: every month or every 'season' – See col. 3, Ins. 30-48 & col. 5, In. 34 et seq.);
- that the specifying means provides for specifying a specific year (Kuchenrither: See col. 3, Ins. 30-48 & col. 5, In. 34 et seq.);

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- that the displayed edited map data is of a different year (Kuchenrither: See Figs. 3-9);
- that the different edited map data is edited map data of a different year (Kuchenrither: See col. 3, Ins. 30-48 & col. 5, In. 34 et seq.);

It would have been obvious to a person having ordinary skill in the art to combine the overlaying technology of Bormans with the navigation device of Bertrand '989. The motivation to combine is suggested by Bormans which discloses that use of the overlaying technology of Bormans avoids the need to compare old maps and new maps by a draftsman to manually generate new combined maps (Bormans: col. 1, Ins. 21-59), and allows speedy generation of updated complex maps from multiple pre-existing maps.

It would have been further obvious to a person having ordinary skill in the art to combine the time period comparison of Kuchenrither to Bertrand '989 and Bormans in combination. The motivation to combine is suggested by Kuchenrither, which discloses time period comparisons as one of many desirable parameters to compare cartographic data to monitor change over time (Kuchenrither: See col. 3, Ins. 30-48 & col. 5, In. 34 et seq.).

Claim 2:

Regarding Claim 2, the combination of Bertrand '989, Bormans and Kuchenrither as applied to Claim 1 above (hereafter 'Bertrand/Bormans/Kuchenrither') discloses the navigation device of claim 1, as above, wherein the map data from the different year

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includes the latest map data (Bormans: See Abstract & col. 2, Ins. 4-39; Kuchenrither: See col. 3, Ins. 30-48 & col. 5, ln. 34 et seq.) as claimed.

Claim 4:

Regarding Claim 4, Bertrand/Bormans/Kuchenrither discloses the navigation device of claim 2, as above, wherein the emphasized data items include road information, facility information, etc. (Bertrand: See Figs. 6-8; Bormans: See col. 2, Ins. 4-39; Kuchenrither: See Figs. 3-9) as claimed.

Claim 5:

Regarding Claim 5, Bertrand/Bormans/Kuchenrither discloses the navigation device of claim 1, as above, wherein the map data includes data items and said displaying means displays emphasized data items in a visually weakened state (Bormans: in a different color and/or with dotted lines – See Figure) as claimed.

Claim 6:

Claim 6 is rejected on substantially the same basis as Claim 4, in light of the basis for claim 5. See the discussions regarding claims 1, 4 and 5 for the details of this disclosure.

Claim 8:

Claim 8 is rejected on substantially the same basis as Claim 1 (supra). Specifically, Bertrand/Bormans/Kuchenrither discloses a navigation device for displaying data map data, comprising... (See Claim 1 above for all)...and displaying means (See above) for displaying the edited map data of a specific year in a first display area, and the edited map data of a different year in a second display area at the same

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time (Bormans: See Figure; Kuchenrither: See col. 3, Ins. 30-48 & col. 5, In. 34 et seq.) as claimed.

Claim 9:

Claim 9 is rejected on substantially the same basis as Claim 2, in light of the basis for claim 8. See the discussions regarding claims 1, 2 and 8 for the details of this disclosure.

Claim 10:

Regarding Claim 10, Bertrand/Bormans/Kuchenrither discloses the navigation device of claim 1, as above, further comprising searching means for searching an updated portion of the map data based on the specified year and a data item (Bertrand '989: col. 3, Ins. 38-47; col. 3, In. 63 to col. 4, In. 9; Kuchenrither: See col. 3, Ins. 30-48 & col. 5, In. 34 et seq.). Specifically, Bertrand '989 teaches a generic user interface. As combined with Bormans and Kuchenrither which provide additional time access functionality, the Bertrand '989 user interface is enabled to accomplish searches over a time period as well.

Claim 11:

Claim 11 is rejected on substantially the same basis as Claim 4, in light of the basis for claim 10. See the discussions regarding claims 1, 4 and 10 above for the details of this disclosure.

Claim 12:

Claim 12 is rejected on substantially the same basis as Claim 1. See the discussion regarding claim 1 above for the details of this disclosure.

Claim 13:

Claim 13 is rejected on substantially the same basis as Claim 8. See the discussion regarding claim 8 above for the details of this disclosure.

Response to Arguments

4. Applicant's arguments filed 10 January 2006 have been fully considered but they are not persuasive.

Referring to applicant's remarks on pages 7-12 regarding the Section 103 rejections of the independent claims: Applicant argued that none of the cited references comparatively display dated map data at the same time using emphasized data items and normal data items.

The examiner disagrees for the following reasons: Bormans clearly shows concurrent (i.e. "at the same time") display of dated map data from two different dates/times having both emphasized data items and normal data items. Applicant's contention that Bormans' method results in a new map "which is totally different from that of the present invention" is not germane to the *prima facie* case of obviousness because the claims do not require, prohibit or otherwise limit anything regarding a "new map." Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Whether or not Bormans' method results in a new map, the fact remains that Bormans explicitly shows overlaid display of two dated maps with emphasized data

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items and normal data items **as claimed**. It does not matter if this data being displayed is stored as a “new map” or not. Finally, Bormans does in fact display both emphasized data items and normal items, and distinguishes between items from the two different maps being overlayed on the display (from a specific year and a different year in light of the combination as a whole). Specifically, in Column 2, lines 10-12 Bormans explicitly states that the two maps being superposed on the display means are distinguished by different colors. Thus, applicant’s contention that “one observing the new map of Bormans cannot determine which map items are new and which map items are old” is completely untrue. Furthermore, Bormans also discloses emphasis of reference points and other map data items by using broken lines (emphasis) vs. solid lines (normal) as claimed. Therefore, the combination as a whole renders the claimed invention obvious, even as amended.

Referring to applicant’s remarks on pages 12-13 regarding the Section 103 rejections of the independent claims: Applicant argued that there is no motivation to combine the cited prior art references other than hindsight provided by Applicant’s specification.

The examiner disagrees for the following reasons: In response to applicant’s argument that the examiner’s conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation to combine can be found in the references themselves. Specifically, motivation is suggested by Bormans which discloses that use of the overlaying technology of Bormans avoids the need to compare old maps and new maps by a draftsman to manually generate new combined maps (Bormans: col. 1, Ins. 21-59), and allows speedy generation of updated complex maps from multiple pre-existing maps, as well as Kuchenrither, which discloses time period comparisons as one of many desirable parameters to compare cartographic data to monitor change over time (Kuchenrither: See col. 3, Ins. 30-48 & col. 5, ln. 34 et seq.).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 571-272-4020. The examiner can normally be reached on M-F, 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bdg
30 March 2006


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